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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,293	01/02/2002	Arnold B. Finestone	82017-1399	1249

28765 7590 10/24/2003

WINSTON & STRAWN  
PATENT DEPARTMENT  
1400 L STREET, N.W.  
WASHINGTON, DC 20005-3502

EXAMINER
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AUGHENBAUGH, WALTER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 10/24/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

10/038,293

Applicant(s)

FINESTONE ET AL.

Examiner

Walter B Aughenbaugh

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See continuation sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See paragraph 3 of continuation sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 12-25.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

**ADVISORY ACTION*****Acknowledgement of Applicant's Amendments***

1. The amendment made in claim 1 made in Applicant's After Final Amendment filed October 1, 2003 (Paper 8) has not been entered due to the fact that it raises new issues that would require further consideration and/or search. Note that claim 19 is incorrectly labeled as "(currently amended)" in Paper 8; claim 19 was amended as marked in Paper 8 in the previous amendment filed April 29, 2003 (Paper 5).

***ANSWERS TO APPLICANTS ARGUMENTS***

2. Applicant's arguments regarding the 35 U.S.C. 103 rejection of claims 12-20 repeated in paragraph 12 of Paper 6 (pages 3-4) and of claims 21-25 made of record in paragraph 14 of Paper 6 (pages 4-6) have been fully considered but are not persuasive.

Applicant argues that "certain materials may not need to be provided with a sealant", but Redmond nonetheless teaches the sealant layer, which corresponds to the reinforcing film as claimed as stated in paragraph 10 of Paper 4. Applicant argues that "In order to properly function, Redmond's sealant cannot be of high strength" and that "If the sealant were of high strength, it could not be punctured by the stiff material, so that the contents of the package could not be dispensed", but the limitations on which the Applicant relies (i.e. "high strength") are not stated in the claims. It is the claims that define the claimed invention, and it is the claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064. Applicant points out that the stiff material of Redmond "is not sufficiently hard or rigid" (ninth-tenth lines of page 7 of Paper 8); "sufficiently" for what purpose? Applicant states that the stiff material of Redmond, supposedly, "cannot be too strong or highly rigid or

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else it will be difficult to break even with the cut lines”, but no evidence is provided by Applicant to show that the oriented film taught by Redmond and Finestone et al. is “too strong or highly rigid” according to the teachings of Redmond. Examiner disagrees that the claimed oriented film “cannot be used as sealants in Redmond’s package” as Applicant argues; the structure taught by Redmond that enables the package of Redmond to be “an easy opening package” as Applicant characterizes the package of Redmond has nothing to do with the structure claimed in the instant application. The package taught by Redmond and Finestone et al. as discussed in paragraphs 12 and 14 of Paper 6 would be “easy opening” with a readily available knife or pair of scissors; the method that one uses to open the package of Redmond is irrelevant to the patentability of the package that is claimed in the instant application as is determined by the structure of the package of the claimed application. The teaching of Redmond that the package is an easy opening package is a teaching in regard to the manner in which the package is intended to be employed, and does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQd 1647 (1987). Furthermore, as pointed out on page 9 of Paper 6, a monoaxially stretched film, which is included in the scope of the teachings of Finestone et al. (see col. 5, lines 9-19), replaced with the sealant of Redmond would result in a package that is easy opening because the laminate would be maximally difficult to tear in one direction along the planar surface of the laminate, but easy to tear in the direction perpendicular to this maximally difficult direction along the planar surface of the laminate.

Applicant argues that “Redmond teaches away from the use of thin sheets or laminates in col. 1, lines 46-61” because “Skilled artisans would realize that such sheets are preferably made

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of oriented plastics for strength”, but this passage from Redmond does not remotely suggest that the reason that these “thin sheets or laminates” are difficult to open because they are formed from an oriented plastic. Applicant alleges that “skilled artisans would also understand that Redmond specifically teaches against the use of plastic and foil laminates”, but Redmond explicitly teaches “the use of plastic and foil laminates” (see col. 3, lines 34-66).

Applicant alleges that “an oriented film would have sufficient strength and flexibility to conform to the shape of the bent stiff material without fracturing or breaking”, but a monoaxially oriented film, as discussed above, would break, allowing the contents of the package to be dispensed. Applicant argues that “a skilled artisan reading Redmond would be taught to use a wax or plastic coating or a weak film rather than an oriented plastic film”, but a monoaxially oriented film is a plastic coating that is maximally weak in a given direction as discussed above, used as the coating of Redmond would enable the container of Redmond to be easily opened.

Applicant argues that “the Finestone et al. laminates are made of paper-plastic or paper-plastic-paper ... [that] would not provide a moisture resistant surface”; however, Redmond teaches the structure as claimed in terms of the order of the layers and Finestone et al. is relied upon for the teachings of orientation, corona surface treatment and “cold” lamination. The Office Action does not propose substituting the various laminates taught by Finestone et al. with the sealant layer of Redmond.

The second-to-last paragraph of page 8 of Paper 8 is copied verbatim from page 7 of Paper 5. The arguments presented on page 7 of Paper 5 are addressed on page 9 of Paper 6. Applicant’s argument that “the functionality of Redmond’s invention would be impaired” is additionally addressed above.

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3. The Declaration of Arnold B. Finestone, Ph.D. (Paper 10) has been received and considered by Examiner. The content of the Declaration is a rehash of Applicant's arguments and opinions presented in Paper 8, or vice versa, which have been addressed above in this Office Action. Furthermore, data supporting Dr. Finestone's opinions and assertions is not presented.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

*Conclusion*


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 703-305-4511. The examiner can normally be reached on Monday-Thursday from 9:00am to 6:00pm and on alternate Fridays from 9:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 703-308-4251. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

wba  
10/22/03

WBA

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

10/22/03